

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Damir et al.

Attorney Docket No. SWAD-1-1002

Serial No.: 10/751,070

Group Art Unit: 3765

Filing Date: January 2, 2004

Examiner: Gloria M. Hale

Title: SWADDLING BLANKET

**APPEAL BRIEF**


**TO THE COMMISSIONER FOR PATENTS:**

This brief is in furtherance of the Notice of Appeal, filed in this case on June 30, 2008.  
The fees required under CFR § 41.20(b)(2) are submitted herewith.

**25315**

CUSTOMER NUMBER

**BLACK LOWE & GRAHAM<sup>PLLC</sup>**

  
701 Fifth Avenue, Suite 4800  
Seattle, Washington 98104  
206.381.3300 • F: 206.381.3301

I. REAL PARTY IN INTEREST

SwaddleDesigns, LLC is the assignee of the present application and is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

Claims 39, 41, and 44-51 are pending. Claims 39, 41, and 44-51 were rejected in the Final Office Action mailed April 30, 2008. The final rejection of Claims 39, 41, and 44-51 is appealed.

IV. STATUS OF AMENDMENTS

An amendment was filed on December 12, 2007 in response to the Non-Final Office Action mailed July 12, 2007, which rejected all claims under 35 U.S.C. § 112, though patentable matter was recognized in the currently pending Claims 39, 41, and 44-51. The subsequent Final Office Action, mailed April 30, 2008, rejected the same claims as obvious. No further amendments to the claims have been made or requested.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention relates to generally to a blanket with attached illustrations instructing the user as to the proper manner for swaddling an infant.

Independent Claim 39 recites a blanket for swaddling an infant, the blanket comprising: a generally planar sheet of textile material having a first-fold illustration, second-fold illustration, and third-fold illustration attached to the blanket and being integrated into a sequence: the first-fold illustration locating and instructing the folding of a first fold line and folding of the blanket to cover the infant; the second-fold illustration locating and instructing the folding of a second fold line and folding of the blanket to cover the infant; and the third-fold illustration locating and instructing the folding of a third fold line and folding of the blanket to cover the infant.

VI. GROUNDINGS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 39, 41 and 44-51 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Isola et al.* (U.S. Patent No. 3,613,133) and common knowledge.

VII. ARGUMENT

**Summary that the Rejections Based Upon *Isola et al.* in View of Common Knowledge are Improper**

The rejection of the claims based upon *Isola* as a reference in view of Common Knowledge is improper for the reason that the rejection fails to recognize the claimed element of attachment of instructive folding illustrations to the blanket, as set forth in the words of independent Claim 39.

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001).

The factual inquiry is one of whether to combine references must be thorough and searching and it must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’” (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (“there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant”); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined only if there is

some suggestion or incentive to do so.”) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades the applicable authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (“the examiner can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references’”).

Knowledge in the prior art of every element of a patent claim, however, is not of itself sufficient to render claim obvious. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966); *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1333, 63 USPQ2d 1374, 1386 (Fed. Cir. 2002). The Supreme Court, in *KSR, supra*, agreed that the Federal Circuit's predecessor, the Court of Customs and Patent Appeals, had “captured a helpful insight” in 1961 when it “first established the requirement of demonstrating a teaching, suggestion, or motivation to combine known elements in order to show that the combination is obvious”:

“Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered,

and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.”

In the instant case, the Examiner has suggested the act of placing written content on the blanket is known, and thus, the content that is placed there is of little or no patentable significance:

*Isola et al.* discloses a blanket 16 with illustrations thereon. *Isola et al.* discloses that any known illustration desired can be placed on the blanket including scenes, articles and persons etc. (See *Isola et al.*, col.11, lines 8-48 and figure 16; and col. 5, line 41- col. 6, line 16). However, *Isola et al.* does not specifically disclose the fold illustrations on the blanket as especially claimed. Accordingly it would have been obvious to one having ordinary skill in the art to place any desired indicia on the blanket as desired for aesthetic purpose or for directions such as that disclosed in *Isola et al.* *Isola et al.* also discloses the placement of a person on a blanket. The illustration is painted on the blanket and is reproduced in any known manner such as those claimed that are well known indicia processes. (See col. 11, lines 35-49). The illustrated method of swaddling a baby in place of *Isola et al.* placement of a person on a blanket is just a change in a printed matter and would be an obvious substitution of common knowledge information that would only be limited by the imagination of the user. The only difference of the claimed invention over *Isola et al.*'s invention is the printed matter and that is not a patentable claim distinction. Since the only difference is the content of the information set forth by the indicia, then this difference is not set forth as a patentable distinction. It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. Therefore when the prior art describes all of the claimed structural and functional relationships (in this case the function of the printed matter on the blanket shows the placement of the user and wherein the blanket surfaces support the indicia, which is the same function as *Isola et al.* (between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given patentable weight. (See *in re Ngai*, 367 F 3d.1336,70 USPQ2d 1862 (Fed. Cir. 2004)).

Final Office Action, pp 2-3.

For the rejection, the Examiner relies upon *Ngai*, for the proposition that adding written matter to an existing device is not a patentable innovation. Known as the “Written Matter” doctrine, it has drawn frequent criticism from the courts as lacking in more germane analysis as

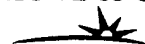
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BLACK LOWE & GRAHAM <sup>PLLC</sup>



701 Fifth Avenue, Suite 4800  
Seattle, Washington 98104  
206.381.3300 • F: 206.381.3301

to actual patentability. In *Ngai*, instructions for a novel use of a known kit of ingredients did not make the subject matter a distinctly patentable invention.

The Examiner's reliance upon *Ngai* is misplaced as the instant claims are directed to a device where the printed matter has a functional relationship to the substrate as in an earlier case, *In re Gulack*:

Ngai argues that the addition of new printed matter to a known product makes the product patentable. He rests his argument on the fact that claim 19 is limited to kits containing instructions teaching the method described in claim 1. Ngai argues that because prior art does not teach a limitation of "instructions describing the method of claim 1," combined with an amplification kit, the petitioner's claim cannot be anticipated. Ngai relies on the language of *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983): "[The] difference between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter." *Id.* at 1385.

The PTO argues that Ngai's claim merely teaches a new use for an existing product. Thus, according to the PTO, Ngai can claim the new use as a method, but he cannot claim the existing product itself. The PTO relies on a different passage of *Gulack* and argues that in order to qualify under *Gulack*, the printed matter must be functionally related to the underlying object. "The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." *Id.* at 1386.

The dispute between Ngai and PTO reduces to the question of the proper meaning of *Gulack*. The PTO has the better argument. In *Gulack*, the Board rejected a claim directed to a circular band designed for mathematical and educational purposes. The invention consisted of "(1) a band, ring, or set of concentric rings; (2) a plurality of individual digits imprinted on the band or ring at regularly spaced intervals; and (3) an algorithm by which the appropriate digits are developed." *Id.* at 1387. The rejection was premised upon the fact that a circular band with items printed upon it was well known in the art. *See id.* at 1384. We reversed, finding that the numbers printed on the band had a functional relationship to the band itself. The Court stated: "the[] digits are related to the band in two ways: (1) the band supports the digits; and (2) there is an endless sequence of digits--each digit residing in a unique position with respect to every other digit in an endless loop. Thus, the digits exploit the endless nature of the band." *Id.* at 1386-87. Although the prior art disclosed a band with printed matter, the Court concluded that the prior art neither "disclosed nor suggested either feature" of *Gulack's* invention. *Id.* at 1387.

*In re Ngai*, 367 F.3d 1336, 1338-1339 (Fed. Cir. 2004).

In fact, if the Examiner herself believed that *Ngai* dictated a conclusion that the exact content of the printed matter is irrelevant, the Examiner would have rejected the claims on anticipation rather than obviousness reasons. It is Appellants' position that the rejection of the claims on a "printed matter" basis is simply incorrect in this case, and the nature of the rejection admits that. Unlike *Ngai*, the instructions are attached and that attachment is a distinct element. Appellants have repeatedly argued throughout the prosecution of the current claim set that the invention is not simply a blanket and a set of instructions, but rather that the blanket and the set of instructions are functionally linked as were the characters of *Gulack*: "the[] digits are related to the band in two ways: (1) the band supports the digits; and (2) there is an endless sequence of digits--each digit residing in a unique position with respect to every other digit in an endless loop. Thus, the digits exploit the endless nature of the band." *Gulack* at 1386-87.

In the instant case, the instructions have a real and tangible link to the blanket: (1) the blanket supports the illustrations; and (2) the illustrations aid in the appropriate use of the blanket during times when the infant is crying and ready reference to the instructions might be necessary given a user's emotional state. Independent Claim 39 and the remaining claim include limitation that instructive illustrations be attached to the blanket. The attachment between blanket and instructions has been intimately related to the utility of the invention as taught in the specification, unlike *Ngai* wherein it was the mere inclusion of instructions in a kit that had a separate cited utility. It is the claimed "attachment" that has been largely ignored as a limitation by the Examiner throughout the prosecution process. Instead, as is demonstrated by the current rejection of claims in view of *Isola et al.*, the Examiner is unwilling to view this bond between instruction and blanket as a distinct element of the claim.

The state of the law is *Gulack*. *Ngai* does not purport to change the law as it is set forth in *Gulack*, but it does assert that it applies *Gulack* to the facts of the case before it. Therefore, the admonitions in *Gulack* must retain all of their full vigor. *Gulack* cautioned against a liberal use of "printed matter rejections" under section 103:

A "printed matter rejection" under § 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed

matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art. . . . [The Court of Customs and Patent Appeals], notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated. *Gulack*, 703 F.2d at 1385 n.8.

*In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994).

As the *Gulack* court properly noted, 35 U.S.C. § 103(a) requires that the invention be viewed as a whole:

§103. Conditions for patentability; non-obvious subject matter.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are *such that the subject matter as a whole would have been obvious at the time the invention was made* to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

It is ironic that citation to *Isola et al.* itself admits that there exists a separate element that is the link between the blanket and what is printed on it. *Isola et al.* is directed to "A set of bed clothes including at least two individual bed clothes elements, one at least partly overlying the other; the elements having means provided thereon defining a composite pictorial illustration of a person, character, animal, article, or scenic background, with the composite illustration consisting of the person, character, etc. appearing in one condition on one of the bed clothes elements and appearing in a different condition on the other of the elements, so that when the bed is viewed with one of the elements overlying the other thereof, the depicted person, character, etc. appears to be in one condition, and when the uppermost of the elements is at least in part removed or folded back from its overlying relation to the other of the elements, the person, character, etc. is viewed as being in the second condition." Abstract, U.S. Patent No. 3,613,133. Certainly no one asserts that the bed clothes were a novel element. Likewise, neither the illustrations of Raggedy Ann™, Raggedy Andy™, nor the image of the Spaceman shown in the illustrations, FIGS 1-4b, impart separate patentability. *Isola et al.* was granted based upon the additional element of the presence of the characters on the bed clothes. Now the Office seeks to



rely upon this patent to disavow the presence of distinct content, but whose nature the *Isola et al.* grant specifically recognizes.

In this case, it is the attachment of the graphic instructions to the blanket that is the patentable limitation present in each of the pending claims. The attachment element lends the patentability to the currently pending claims.

Additionally, the Examiner has vacillated as to the allowability of the claims, alternately recognizing and denying the utility of attachment of the instructions to the blanket. In a prior Office Action dated February 7, 2007, the Examiner stated that Claims 39, 41, and 44-50 would be allowable "if rewritten or amended to overcome the rejection under 35 USC §112." After Appellants did so amend, the Examiner withdrew the offer of allowability. After amending the claims in accord with the stated allowability of the claims, the Examiner, in the July 12, 2007 Office Action, first brought up the citations to *Isola et al.* and *Ngai* to disavow the allowability of Claims 39, 41, and 44-50.

In response to the *Isola et al.* reference, Appellants submitted the Declarations of Lynette Damir and Pamela Jordan. Attachment 1 is the Declaration of Lynette Damir, R.N., the inventor of the invention taught in the instant application; Attachment 2 is the declaration of Pamela Jordan, Ph.D., R.N. Each of the Declarations addresses the absence of a similar product in the marketplace. Both go on to assert additional indicia of uniqueness of the instant invention in the manner set forth as "secondary considerations" in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), where the United States Supreme Court clarified the nonobviousness requirement in United States patent law, set forth in 35 U.S.C. § 103. This Response incorporates the two attachments by this reference.

The Patent Act of 1952 added 35 U.S.C. § 103, which added the statutory requirement of nonobviousness. The section essentially requires a comparison of the subject matter sought to be patented and the prior art, in order to determine whether or not the subject matter of the patent as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Congress, in passing the Act, intended to codify and clarify the common law surrounding the Patent Act by making explicit the requirement of nonobviousness. In

*Graham*, the Supreme Court held that, although patentability is a matter of law, § 103 required a determination of the following questions of fact to resolve the issue of obviousness:

- the scope and content of the prior art;
- the level of ordinary skill in the prior art;
- the differences between the claimed invention and the prior art; and

In addition, the Court mentioned “secondary considerations” which could serve as indicia of nonobviousness. They include:

- commercial success;
- long-felt but unsolved needs; and
- failure of others.

The record now includes the two declarations attesting to the presence of the *Graham* factors as secondary indications of nonobviousness. For a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements, features and steps of the claim at issue. *See, e.g., In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). *Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc.*, 45 F.3d 1550, 33 USPQ 2d 1496 (Fed. Cir. 1995) (“the claimed process, including each step thereof, must have been described or embodied, either expressly or inherently.”) As clearly articulated in M.P.E.P. § 2143.03, “[to] establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (C.C.P.A. 1970). (Emphasis added.)

In *KSR*, cited above, the Supreme Court reaffirmed the importance of secondary considerations when reviewing an application for patentability. The policy of the United States Patent and Trademark Office is to follow *Graham v. John Deere*. M.P.E.P. § 2141. A procedure for evaluating an application in light of the *Graham* case is set forth at M.P.E.P. § 2141, which

requires that objective evidence must be considered. The Examiner has not duly recognized the significance of these Declarations in determining the nonobviousness of the claims.

As Mrs. Damir, in her Declaration, points out, the blanket has enjoyed tremendous commercial success, especially in discriminating markets as well as a long-felt need, the failure of others, and copying by others. As the Examiner certainly is aware, the Courts have held that such evidence is suitably conclusive on the issue of non-obviousness: Mrs. Damir suitably points out incidents of praise and industry acceptance (each relevant under *Allen Archery, Inc. v. Browning Mfg. Co.*, 819 F.2d 1087, 1092, 2 USPQ2d 1490, 1493 (Fed. Cir. 1987) as well as copying (*Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675,679, 7 USPQ2d 1315, 1319 (Fed. Cir. 1988)). In light of the supplied evidence, the claims are not obvious. Appellants assert that the rejection on the basis of obviousness can no longer stand in light of this evidence of secondary considerations.

The Supreme Court of the United States and the Federal Circuit Court of Appeals have also provided further guidance for resolving the question of obviousness. "An obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 167 L.Ed.2d 705 (2007)." *Leapfrog Ent., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 82 USPQ2d 1687 (Fed. Cir. 2007). (Emphasis added.)

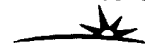
"Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does. Inventions usually rely upon building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what, in some sense, is already known." *KSR* at 1731.

In *KSR, supra*, the Supreme Court noted that it will be necessary for a court "to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be explicit." *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 1746, 1741 (2007). "[R]ejections on obviousness grounds

cannot be sustained by mere conclusory statements; instead, *there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*" *Id.* at 1746, quoting *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006). (Emphasis added.)

In decisions after *KSR*, *supra*, the Board of Patent Appeals and Interferences has failed to sustain obviousness type rejections when the Examiner has failed to make a proper prima facie case of obviousness. See *Ex parte Katoh et al*, Appeal 2007-1460 (obviousness rejection not sustained because there was "no evidence or suggestion" in the reference for the alleged configuration); and *Ex parte Crawford et al*, Appeal 2006-2429 (obviousness rejection not sustained because there was no suggestion to combine the references in the manner suggested by the Examiner except for using Appellants' invention as a template through hindsight reconstruction of Appellants' claims).

In this case, the blanket with attached instructive illustrations was first found to be allowable matter. Since then, the Examiner has failed to show why citation to *Isola et al.* renders the instant claims obvious when no such blanket has earlier existed on the market and when, upon its introduction, the market immediately accepts the blanket and copiers spring up to exploit that acceptance. These indicia are at the heart of the *Graham* Court's finding of nonobviousness, and militate for a similar finding in this case.



VIII. Conclusion

The only evidence on the record is the Declarations of Dr. Jordan and the inventor, herself a registered nurse and expert in the field. They militate toward a finding of nonobviousness as they show that the market place has immediately recognized the value of the blanket. In spite of the Examiner's suggestion that nothing in the Declarations links the success and copying to the claims under examination, the Examiner has not offered any contradictory evidence, nor any reference that itself includes instructive swaddling instructions *attached to the blanket*. In light of this fact, and, the *Graham* factors having been suitably made part of the record, the Claims as currently entered should be allowed.

Respectfully submitted,

BLACK LOWE & GRAHAM<sup>PLLC</sup>



Mark L. Lorbiecki  
Registration No. 45,643  
Direct Dial: 206.903.1800

IX. CLAIMS APPENDIX

39. A blanket for swaddling an infant, the blanket comprising:

a generally planar sheet of textile material having a first-fold illustration, second-fold illustration, and third-fold illustration attached to the blanket and being integrated into a sequence;

the first-fold illustration locating and instructing the folding of a first fold line and folding of the blanket to cover the infant;

the second-fold illustration locating and instructing the folding of a second fold line and folding of the blanket to cover the infant; and

the third-fold illustration locating and instructing the folding of a third fold line and folding of the blanket to cover the infant.

41. The blanket of Claim 39, wherein the blanket further comprises a no-fold illustration locating and instructing the placement of an infant on the blanket.

44. The blanket of Claim 41, where the first-fold, second-fold, and third-fold illustrations are attached to the blanket in positions orienting the blanket with respect to the infant.

45. The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are printed on the blanket.

46. The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are embroidered on the blanket.

47. The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are embossed on the blanket.

48. The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are labeled on the blanket.

49. The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are appliquéd on the blanket.

50. The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are woven into the blanket.

51. The blanket of Claim 39, wherein the first-fold, second-fold, third-fold illustrations are detachably attached to the blanket.

X. EVIDENCE APPENDIX

Attachment 1 – Declaration of Lynette Damir, R.N., the inventor of the invention taught in the instant application and a registered nurse.

Attachment 2 – Declaration of Pamela Jordan, Ph.D., R.N.

XI. RELATED PROCEEDINGS APPENDIX

Exhibit 1 – February 7, 2007 Office Action.



# **Attachment 1**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Damir et al.

Attorney Docket No. SWAD-1-  
1002

Serial No.: 10/751,070

Group Art Unit: 3765

Filing Date: January 2, 2004

Examiner: Gloria HALE

Title: SWADDLING BLANKET

**DECLARATION OF LYNETTE DAMIR, RN**

TO THE COMMISSIONER OF PATENTS:

Lynette Damir, RN, does declare the following to be true:

I am the inventor of the invention taught in the subject application, have expertise in the field of newborn care with a focus on swaddling as a technique for calming and comforting newborns, and make the following statements that are true and accurate to the best of my knowledge:

I have been formally trained as a registered nurse and have been involved in the care of newborns both within and outside of the hospital setting. I have been formally trained in the care of newborns and the practice of swaddling. I have been a licensed and registered nurse since 1987. As a student nurse I conducted my first family visit in 1986 and instructed new parents per their request on swaddling technique because they could not remember how the nurses swaddled their baby at the hospital.

I have read extensively on the subject of swaddling including, but not limited to, the following: The Essentials of Pediatric Nursing by Whaley and Wong, The American Academy of Pediatrics Caring for Your Baby and Young Child, Birth to Age 5 by Steven Shelov MD, FAAP, Editor-in-Chief, Your Baby and Child by Penelope Leach, Babyhood by Penelope Leach, The Happiest Baby on the Block by Dr. Harvey Karp, Pregnancy, Childbirth and the Newborn by Simkin, Whalley and Keppler, Helping Your Child Sleep Through the Night by Cuthbertson and

Schevill, Sleeping Through the Night by Jodi Mindell, Nighttime Parenting by William Sears, Developmental Care of Newborns & Infants - A guide for Health Professionals by Kenner and McGrath, Gentle Baby Care by Elizabeth Pantley, The No Cry Sleep Solution by Elizabeth Pantley, The Baby Book by Sears and Sears, Touchpoints by T. Berry Brazelton, MD, Touch: The Foundation of Experience by Barnard and Brazelton, Journal of Pediatrics 2002, 2006, Child Development 1989, Pediatrics 2002, 2005, The American Academy of Pediatric website, The Consumer Products Safety Commission website, The National Institute of Child Health and Human Development website.

I have interviewed and surveyed new and experienced parents locally, across the USA, Canada, UK, Mexico, Spain, Korea, Australia and New Zealand to seek a deeper understanding of swaddling practices across different social and economic groups of parents.

During my research, I consulted with PhDs in the field of infant research including: Dr. Kathryn Barnard PhD, FAAN, Winner of the Gustav O. Lienhard award and leading infant researcher, regarding hand position when swaddling; Pamela Jordan, PhD, RN, Associate Professor School of Nursing at University of Washington, and Developer of The Becoming Parents Program, regarding proper swaddling technique for instruction for new parents; Lark Young, RN, Community Education Manager at Overlake Medical Center, Bellevue, Washington regarding proper swaddling technique for the purpose of instruction to new parents; Dr. Harvey Karp, Pediatrician, author of Happiest Baby on the Block; Dr. Larry Holland, Orthopedic Physician, Dr. William Wagner, Orthopedic Physician; Theresa Kledzik, RN, Developmental Nurse Specialist; Brenda Blasingame, MA, Director of Programs at the Talaris Research Institute; Penny Simkin, PT, Co- Founder of Doula's of North America, and Author of Pregnancy, Childbirth and the Newborn; and Tarryn Rivkin, Pediatric Occupational Therapist; and leaders of the La Leche League and CAPPA.

I have provided consultation to Overlake Medical Center in Bellevue, Washington, St. Luke's Medical Center in Boise, Idaho, Group Health Cooperative Hospital in Seattle, Washington.

Prior to my invention, as a proponent for swaddling, I searched the market extensively for blankets that would aid new parents in learning how to swaddle, how to make an effective swaddle and found no blankets with swaddling instructions included with the blanket or sewn to the edge of the blanket.

I make the statements contained herein based upon my training, my experience as a caregiver, my experience as a mother of newborns, my research and my experience as the founder and CEO of SwaddleDesigns, the supplier of the swaddling blankets according to the teachings of the invention.

#### **THE UNIQUE NATURE OF THE BLANKET**

I invented the blanket that is the subject of the patent application because I perceived an intense need for such an instructional blanket when I was visiting new parents. Few, if any of the new parents knew how to properly swaddle a newborn in a fashion that would provide a secure and appropriately snug fit supporting the newborn.

#### **SWADDLING**

I have long been a believer in the practice of swaddling and make this endorsement of the practice of swaddling in contrast to the simple action of wrapping a child in a blanket. Swaddling, properly performed, is a snug wrap with distinct folds that remains secure, and prevents the newborn from startling itself awake, and most importantly, a proper swaddle will not become loose and allow the newborn to wiggle out of the blanket. If the swaddle becomes loose, then the newborn is more likely to become unsettled.



The value of swaddling has been confirmed to be beneficial by medical research culminating in a report published in December 2002. In the report, researchers at Washington University of St. Louis proved swaddled babies sleep better. The study further proved that a properly and securely wrapped baby sleeps better - with fewer awakenings and more REM sleep than unswaddled babies. The American Academy of Pediatrics recommends the back (or supine) position for infant sleep. Swaddled babies sleep for longer periods of time on their back than unswaddled babies and therefore are less likely to be placed by their parents in the unsafe stomach position for sleep. There is a 3-fold increase of SIDS with babies who are put in the stomach position for sleep. In addition, there is evidence that swaddled back sleeping infants have lower incidence of SIDS than unswaddled back sleeping infants as stated in the Journal of Pediatrics, December 2002

Many experts have opined that the snug wrap of a properly swaddled baby reminds that baby of a similar feeling to being in the womb. For that reason, the practice of swaddling eases the transition from womb to world. Swaddling contains the baby's extra movements caused by the startle reflex that can wake a sleeping baby. And, of course, when swaddled babies sleep better, the parents sleep better too.

Understanding the value of the practice of swaddling, I have completed much research to learn more about the practice. In the USA, until the middle of the twentieth century, many young women would have had the opportunity to learn swaddling in the care of siblings and of relatives. As the average sizes of families decreased, and new moms began having babies in cities away from their relatives, the knowledge of swaddling was passed to new mothers in



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SWAD-1-1002 Graham Factors Declaration Damir Final

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hospitals. New moms, generally, stayed in the hospital for five to seven days after giving birth; during that time, they would receive much instruction on newborn care.

In the late 1980s, absent some severe complication, new moms were discharged 24 to 48 hours postpartum. With such a short postpartum stay, there is little time for teaching any skills to the new mothers, thus they very rarely learn how swaddle while at the hospital. Stabilization and recovery of the mother and baby is the central focus of the stay. New mothers are discharged with much to learn in terms of skills necessary or desirable for newborn care.

Learning swaddling has been a particular challenge to new parents. Beginners often give up as they become frustrated with swaddling because they cannot remember the steps to properly swaddle their baby. It is not obvious to new parents how to make the distinct folds to make an effective swaddle. A loosely wrapped blanket or improper swaddle does not contain the baby's extra movements caused by the startle reflex (arms and legs flail) which in turn wakes the baby or the baby can kick-out of the blanket which causes the baby to wake and cry. These frustrations can quickly cause the parent to quit trying to swaddle.

#### **FILLING AN UNMET NEED**

As a nurse and a mom, I am constantly looking for aids to the care of newborn children. Given my profound regard for the practice of swaddling, I began to search the market for swaddling blankets that would help instruct new parents. After an exhaustive search, I could find no blanket that taught swaddling folding techniques and no blanket that included swaddling instructions.

My view of the need required the instructions for swaddling to be on a swaddling blanket. To make an effective swaddle one needs the right kind of blanket and proper technique. Swaddling is a learned art and a difficult one initially. I compare it to learning Origami around a wiggly baby. It is nearly impossible to hold open a book, and follow the swaddling instructions while trying to swaddle a newborn. In the middle of the night when trying to settle their baby,

new parents are not going to turn on the TV to watch a video. The invention, then, was to have the instructions on a strategic spot sewn to the edge or drawn on a suitable blanket. Using such a blanket, the steps of how to swaddle are positioned right at the caregiver's fingers tips and visible while the parent wraps the wiggling child. Instructions to the new parent are placed where they can be most effective.

## **OBVIOUSNESS FACTORS**

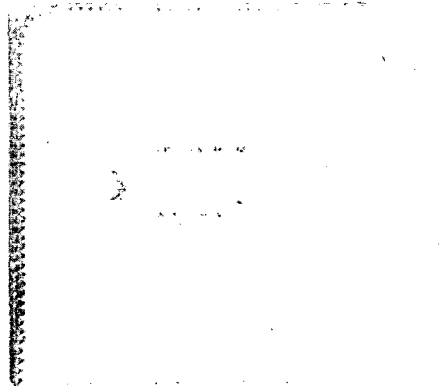
### **THE SCOPE AND CONTENT OF THE PRIOR ART**

It had not been my intent to enter into the business of producing and selling swaddling blankets. Rather, my hope was to find a suitably configured blanket that I could recommend to new parents for properly swaddling their newborns. I searched the Internet and known suppliers of children's clothing and supplies. Repeated and frequent searches unearthed no blankets properly cut for swaddling. Additionally, I could find no blanket with swaddling instructions permanently sewn to it showing how to accomplish swaddling.

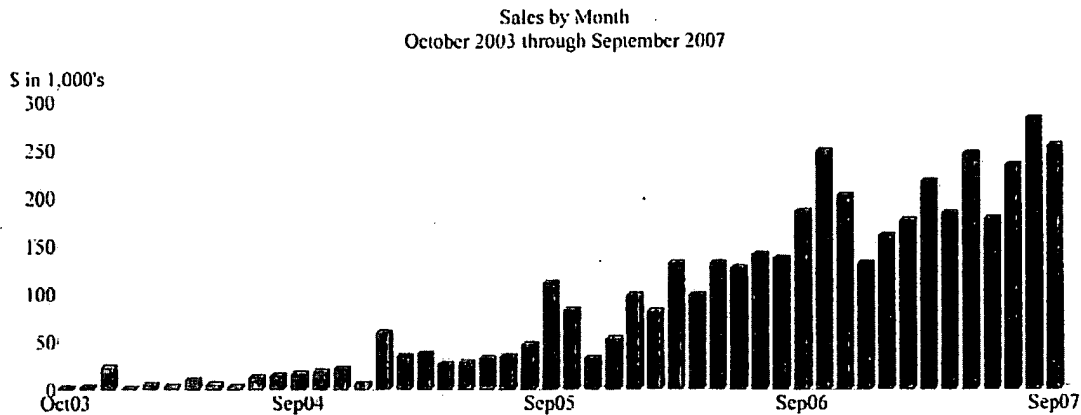
## **OBJECTIVE EVIDENCE OF NONOBVIOUSNESS (GRAHAM FACTORS)**

### **COMMERCIAL SUCCESS**

SwaddleDesigns has grown from a small start-up to reach a point of commercially shipping over 1,000 blankets per day. Over the past four years, SwaddleDesigns has commercially shipped approximately 300,000 blankets. The commercial success has resulted in sales growing by over 2000% over three years. This graph shows the progress in monthly sales of the inventive blanket that is the subject of

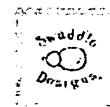


the application:

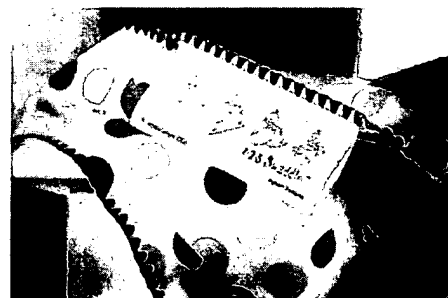


The market is not an easy one to enter or to remain in. The innovative nature of the invention, however, has allowed the assignee, SwaddleDesigns, to become a category leader in the baby blanket industry dominated by Carter's, Gerber and other established companies.

The sales have been to a sophisticated clientele including Nordstrom, BabyCenter, Target.com, Babystyle, BabiesRUs.com, buybuyBaby, giggle, Von Maur, and hundreds of retailers around the world who all carry the SwaddleDesigns blanket. For example, Village Maternity (an independently owned and operated upscale retail maternity and postpartum shop in Seattle, Washington since 1983) and Kid's Club (another upscale retailer in Seattle focusing on children) have carried the SwaddleDesigns blanket since 2003. The blanket appeals to buyers who understood that new parents often struggle when trying to swaddle, and they understand that the



SwaddleDesigns®  
Ultimate Receiving Blanket®  
the only blanket  
with swaddling instructions  
sewn to its edge



www.SwaddleDesigns.com Over 40 colors & prints Made in USA





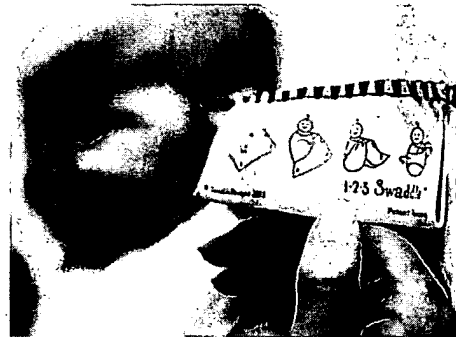
SwaddleDesigns blanket helps new parents learn how to swaddle and comfort their newborns. Today, retailers continue to sell an increasingly higher volume of SwaddleDesigns blankets every month.

In the crowded product category of baby blankets where there is little opportunity to differentiate a product, SwaddleDesigns success bears testimony to the innovation represented by the presence of the instructive tag.

#### **LONG-FELT BUT UNSOLVED NEEDS**

When visiting new parents, I consistently found that parents often struggled when attempting to swaddle their newborns. Parents would repeatedly ask me to show them how to swaddle.

As I have stated above, in 2001 and 2002, I surveyed products on the market and I found many small rectangular receiving blankets, as well as thick or satin backed blankets; none of the available blankets were appropriate for swaddling. In addition, when looking for illustrations, in the many newborn care books available, I



found very few books had illustrations showing how-to-swaddle. I interviewed and surveyed new parents and found that the vast majority didn't know how or couldn't remember how to swaddle, however they stated a desire to be shown how to swaddle like the nurse at the hospital. I believe that these factors, along with the commercial success of the blanket bear testimony to the fact that there has been a long-felt need for the inventive blanket.

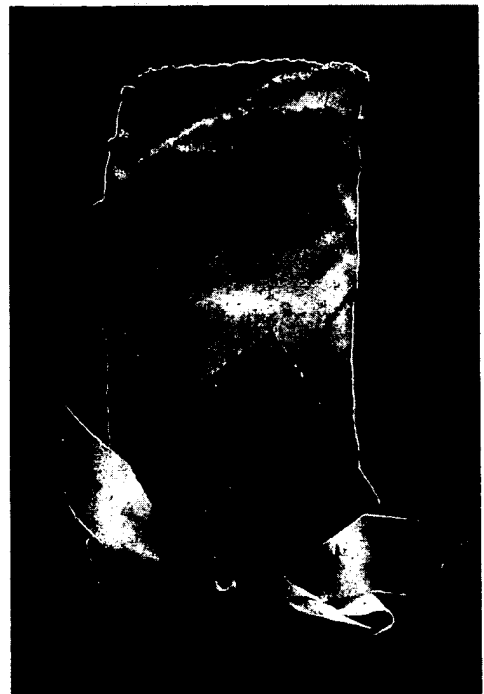
#### **COPYING**

My attorney has explained to me that there are many cases that outline the use of secondary factors to prove novelty and non-obviousness. He further explains that in several

cases, including *Allen Archery, Inc. v. Browning Mfg. Co.*, 819 F.2d 1087, 1092, 2 USPQ2d 1490, 1493 (Fed. Cir. 1987) (considering copying, praise, unexpected results, and industry acceptance as indicators of nonobviousness); and *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679, 7 USPQ2d 1315, 1319 (Fed. Cir. 1988) (considering copying as an indicator of nonobviousness), the Courts have placed great weight upon the fact that once a product is introduced, if copying of that product occurs, the product was non-obvious.

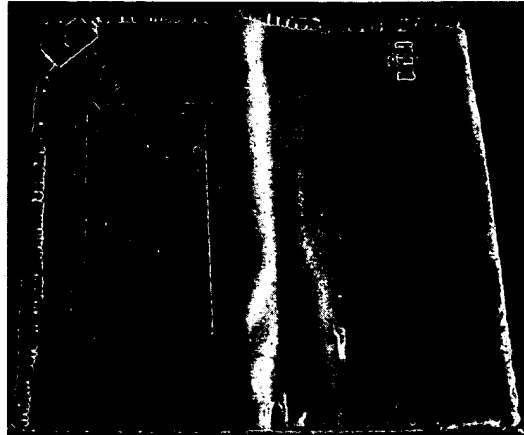
Since the introduction of the subject blanket, several have tried to duplicate it. For example, the retailer Gap was thwarted in its plans to copy SwaddleDesigns blanket. In 2005, the Gap attempted to copy SwaddleDesigns blanket. The Gap swaddle blanket was nearly identical in several ways: (i) same size (42"x42"), (ii) polka dots in the same colors as SwaddleDesigns, (iii) same decorative edge stitch, (iv) same fabric using cotton flannel.

The Gap did not include an instructional tag sewn to the edge of the blanket. A true and accurate photograph of the Baby Gap blanket is shown.



When I, at SwaddleDesigns learned of the Gap swaddle blanket, I did so because consumers sent emails to SwaddleDesigns and asked whether the Gap was copying SwaddleDesigns or whether SwaddleDesigns had partnered with the Gap. In January 2006, a letter to the Gap explaining that SwaddleDesigns was willing to protect their intellectual property in the blanket convinced the management of the Gap that it would be unwise to continue to sell the product. Within a few months after the letter, the Gap reduced the retail price twice and eventually discontinued their knock-off blanket.

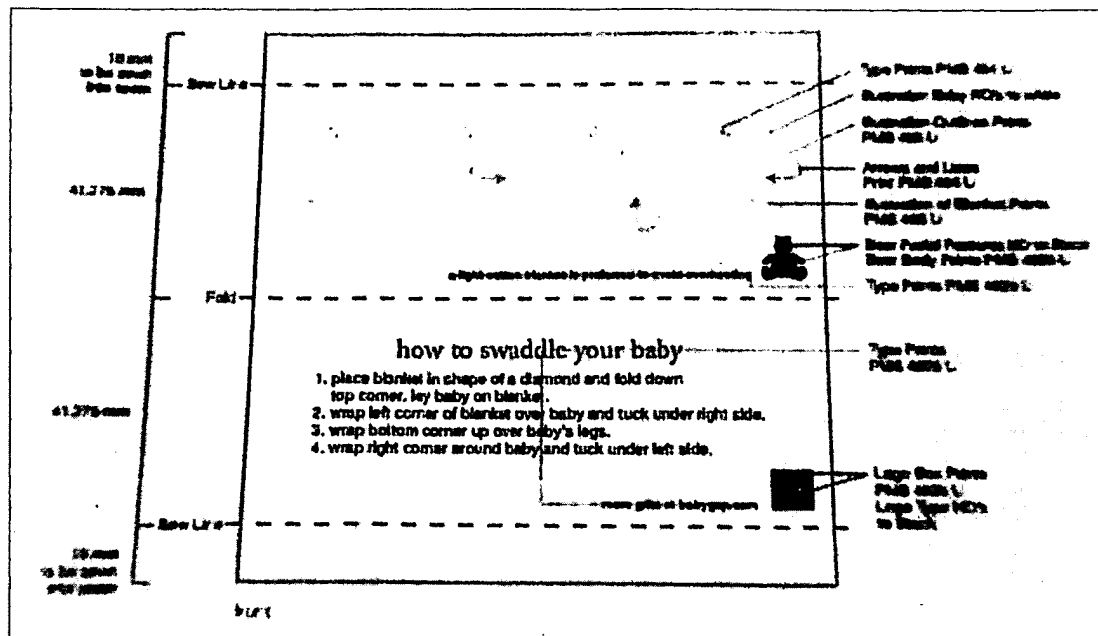
In October 2005, Babystyle, a very high-end regional maternity retailer, attempted to copy SwaddleDesigns Ultimate Swaddling Blanket® by introducing a Babystyle polka dot swaddling blanket as pictured in the true and accurate photograph. The Babystyle blanket was a large square, cotton flannel blanket with a decorative edge and included swaddling instructions in the packaging. However,



Babystyle did not attempt to copy a sewn instruction tag and did not sew instructions to the edge of the blanket. Without the inventive tag, after several months, Babystyle also reduced their blanket price a couple of times due to poor sales and eventually discontinued their product.

Based on the lack of success of their own product and the realization that the inventive tag carrying instructions on the SwaddleDesigns blanket is superior to the blanket without the tag, Babystyle decided to carry SwaddleDesigns Ultimate Swaddling Blanket®. The Babystyle blanket was polka dot, decorative edge, large square, cotton flannel, thus, virtually identical to the SwaddleDesigns Ultimate Swaddling Blanket® with the exception of the primary differentiator between the SwaddleDesigns blanket and the Babystyle blanket, the inventive, instructional tag. Today, Babystyle is one of SwaddleDesigns top 10 customers.

In 2006, there was another incident that illustrates how closely several companies are watching the SwaddleDesigns patent application. Due to an administrative error, the patent application disappeared from the USPTO publicly available web site. Within a short period of time, SwaddleDesigns learned from an unnamed source that the Gap was preparing to copy the SwaddleDesigns Ultimate Swaddling Blanket® instructional label. SwaddleDesigns was sent the Gap label artwork that was destined to Asia for production as shown below. As is apparent by inspection, the label artwork was a near-exact copy bearing the BabyGap legend instead of 123 Swaddle®. In response, SwaddleDesigns sent a letter to the Gap to inform the Gap that our



patent application was still pending. In our vigilant monitoring of the Gap, I can assure you that they have not sold the blanket with the label as shown above.

#### PRAISE

Another factor in *Allen Archery, Inc. v. Browning Mfg. Co.*, 819 F.2d 1087, 1092, 2 USPQ2d 1490, 1493 (Fed. Cir. 1987) (considering copying, praise, unexpected results, and industry acceptance as indicators of nonobviousness) was praise for the invention.

The first customer for the SwaddleDesigns Ultimate Receiving Blanket® was a major hospital in the Seattle area known as Overlake Regional Medical Center. In making the decision to purchase 4,000 blankets each to serve as a departure gift for their new parents, the hospital's management explained that they were very impressed with the educational value of attached instructions for swaddling. The manager of Family and Community Education for the Women Clinical Services department sponsored the program with the support of the hospital's Director. To amplify the expected success of the program, the leadership of the hospital included an article praising the blanket in their quarterly newsletter in 2004.

During the development of the blanket, I met with Pamela Jordan, PhD, RN, Professor School of Nursing at University of Washington. Dr. Jordan is the developer of The Becoming Parents Program, a couple-focused educational program for couples adding a new baby to the family through birth, adoption, or foster parenting. The program teaches survival skills for taking care of their relationship, relating and caring for their baby, and dealing with the many ways that adding a new baby to the family impacts their lives.

I was introduced to Dr. Jordan by Lark Young, RN, Manager of Family and Community Education at Overlake Regional Medical Center. Prior to the final approval of the educational blanket gift program, Overlake management requested

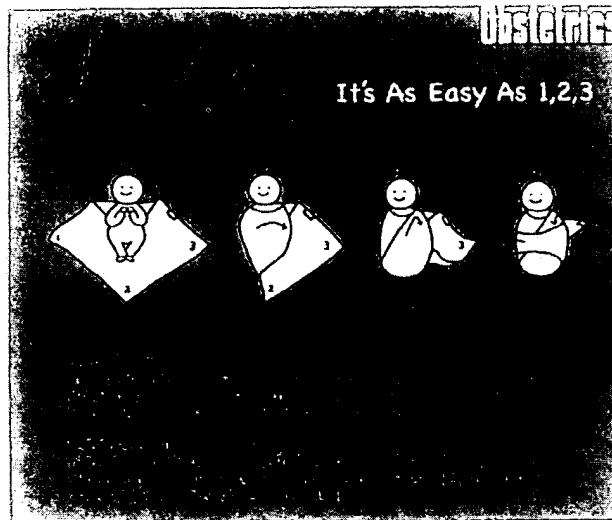
expert review and opinion from Dr. Jordan and her colleagues at University of Washington.

As a medical professional and researcher who has studied the challenges new parents face as they transition to parenthood, Dr. Jordan is an expert in the field. She immediately understood and communicated that the swaddling instructions on the tag would be very helpful to new parents. She stated, "You have a great idea that will help many, many new parents." Furthermore, she stated "she was pleased that a fellow nurse had invented such a wonderful, practical, and educational product."



## Women's Health

Winter 2004



*In the 1990s* Overlake Hospital was aggressive in its support of the American Academy of Pediatrics' (AAP) "Back to Sleep" campaign through educational outreach and special programs. The more care, all babies born at Overlake Hospital received a special t-shirt which conveyed this important safety message. The results of this widespread awareness have been tremendous. The AAP states that SIDS rates have decreased by more than 40 percent since they began the Back to Sleep campaign in 1992.

Today, Overlake is embarking on a new public service campaign, to promote the soothing benefits of swaddling. In the 2002 journal, "Pediatrics," researchers at the Washington University School of Medicine in St. Louis stated, "Infants sleep with fewer awakenings when

swaddled, and swaddling may help sleeping infants remain on their backs."

Infants have been swaddled for generations. The instinctual urge to wrap and secure a baby is a common thread in every culture. And for the past several years, this simple technique has received more attention and acclaim for its calming effects.

As a special gift for all babies born at Overlake, Women's & Children's Services is pleased to present our new "Born at Overlake" blanket. This beautiful blanket is not only soft and cozy, but provides parents a visual guide on how to master the art of swaddling. Educating families about the benefits of swaddling is made easy with this specially sized blanket. The 1-2-3 Needle tip tag is sewn right onto the edge of the blanket as a visual teaching tool for parents.

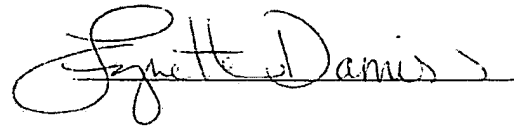
Dr. Jordan shared the design concept with her colleagues and after their collective review, she communicated to me that she would provide Overlake Regional Medical Center with very positive feedback. Soon after, Overlake Regional Medical Center made their first purchase of 4,000 blankets and over the following years, Overlake Regional Medical Center purchased over 10,000 blankets.

When showing my inventive blanket with the instructional tag to individuals who have recently had a baby and especially if they experienced frustration when trying to learn how to swaddle, they typically exclaim, "What a great idea!", "I wish I had this blanket when my son was a baby!" "I love it!" "Where can I buy one, I want to give one to my friend who is expecting." When showing the inventive blanket with the tag sewn into the edge of our blanket to retail buyers, pediatricians, nurses, doulas, parent educators, lactation consultants, or OBs, I have come to expect very similar results. Uniformly, their eyes light up, a smile emerges, they point at the tag and state an enthusiastic positive exclamation such as, "THAT is ingenious!", "How great is THAT!", "THAT is wonderful!", and "What a GREAT idea!" I assert, consistent with the court in *Allen Archery*, that if the blanket weren't novel and non-obvious, people would not consistently react with positive, surprised, and delighted response.

As I have truthfully declared in the facts set forth above, every of the relevant *Graham* factors that applies to the pending application clearly militates for the non-obvious nature of the invention. The current rejection fails to recognize the novel nature of the invention and has been notably and unduly prolonged. Given the clear and unequivocal evidence I present in this declaration, I believe that there can be no reasonable doubt that the *Graham* factors allow for but one reasonable conclusion, that the invention is novel and non-obvious. If the Examiner is in need of further information, I remain at his or her service and will provide, through my attorney of record, declarations and evidence that further proves the non-obvious nature of the invention.

I, Lynette Damir, declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Dated this 3<sup>rd</sup> day of December, 2007.

A handwritten signature in cursive script, reading "Lynette Damir", written over a horizontal line.

# **Attachment 2**



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Damir et al.

Attorney Docket No. SWAD-1-1002

Serial No.: 10/751,070

Group Art Unit: 3765

Filing Date: January 2, 2004

Examiner: Gloria HALE

Title: SWADDLING BLANKET

DECLARATION OF PAMELA JORDAN, PHD, RN

TO THE COMMISSIONER OF PATENTS:

Pamela Jordan, PhD, RN, Associate Professor School of Nursing at University of Washington, and Developer of The Becoming Parents Program, does declare the following to be true:

As an expert on childbearing families it is my expert opinion that the unique and innovative nature of the instructions permanently attached to the SwaddleDesigns blanket has been and will continue to be very helpful to new parents who often struggle when trying to learn how to effectively swaddle their newborn.

Parents have much to learn as they add a new baby to the family. It can be overwhelming for both the new mother and the father. Research has shown that swaddling a newborn helps the baby sleep for longer periods of time, thereby allowing the new mother and father to get much needed rest. For almost twenty years, I have strongly advocated that parents use swaddling as a technique to help calm and comfort their baby.

I have worked predominantly with childbearing families for almost 30 years. I have developed a couple-focused curriculum for couples adding a new baby to the family, and I work extensively with this population. I also teach nursing students and staff nurses to provide research based care to expectant and new parents. I am well aware of the fact that new parents often struggle when trying to learn how to properly swaddle their newborn. They are often overwhelmed and have a difficult time remembering how to make the distinct folds that are

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SWAD-1-1002 Graham Factors Declaration Jordan-Final.doc

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required. It is not obvious to a new parent how to make folds to make the snug and secure wrap, especially when trying to do so while stressed and exhausted.

In all my years of teaching I have never known anyone putting swaddling instructions on a swaddling blanket to help new parents remember how to make the distinct folds until Lynette shared her idea with me. In all my years of teaching I have never known of a swaddling blanket that included the swaddling instructions sewn to its edge for easy reference. The instructions on the blanket make the innovation practical, effective and wonderful aid to new parents.

During my first meeting with Lynette Damir when she shared the design concept for the blanket with swaddling instructions sewn to the edge of blanket, my first reaction was that she had developed a truly innovative and long-needed solution to a problem that troubles many new parents.

Over the past several years, I have used the SwaddleDesigns blanket in my teaching. I have received much positive feedback from the new parents who have used the blanket. I am more confident than ever that the SwaddleDesigns blanket with the swaddling instructions permanently attached to the edge is a truly innovative and unique, and it is much appreciated educational product that helps new parents care for their newborn.

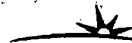
Not only is the SwaddleDesigns blanket unique in that it has the swaddling instructions permanently attached to the edge of the blanket, those instructions are universally understandable because they include only diagrams and numbers. The SwaddleDesigns blanket can therefore be used by people speaking many languages and from many cultures. In addition, the SwaddleDesigns blanket is the only swaddling blanket that specifically instructs parents or caregivers to swaddle the baby with hands up so they are accessible to the baby for self-soothing. This is one of the aspects of the SwaddleDesigns blanket that is based on current research. The SwaddleDesigns blanket is the appropriate size to swaddle babies from newborn to six months or more, and, because it is 100% cotton, can be used in all temperatures and climates without overheating the baby and increasing the risk of Sudden Infant Death Syndrome (SIDS).

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With the swaddling instructions permanently attached to the edge of the blanket, the SwaddleDesigns blanket provides health professionals, parents, and other caregivers of infants an effective, educational, scientifically based swaddling product.

As I have truthfully declared in the facts set forth above.

I, Pamela Jordan, declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Dated this 4<sup>th</sup> day of December, 2007.


Pamela Jordan

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Seattle, Washington 98104  
206.381.3300 • F: 206.381.3301

# **Exhibit 1**



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,070	01/02/2004	Lynette Damir	SWAD-I-1002	1245
25315 7590 02/07/2007 BLACK LOWE & GRAHAM, PLLC 701 FIFTH AVENUE SUITE 4800 SEATTLE, WA 98104			EXAMINER HALE, GLORIA M	
			ART UNIT 3765	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/07/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/751,070

Applicant(s)

DAMIR ET AL.

Examiner

Gloria Hale

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8-17-06RCE with 10-7-05Amendment.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39, 41 and 44-50 is/are pending in the application.
- 4a) Of the above claim(s) 1-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41 and 44-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 45,46,47,48,49 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claim 39 claims the illustrations as being detachably connected to the blanket. Then the dependent claims claim attachments on the blanket that are permanent. Therefore, the exact type of attachment is not clear.

Claims 39,41 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 39,41 and 44 claim illustrations on the blanket. However it is not clear as to how the illustrations are provided on the blanket since they have not been claimed as being embroidered, printed etc.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no support in the specification for the term "first-fold illustration" etc. Only the term "first illustration" etc. has been used. The same terminology must be used throughout the specification.

***Response to Arguments***

Applicant's arguments filed 10-07-05, with respect to the prior art rejection have been fully considered and are persuasive. The prior art rejection of 4-5-05 has been withdrawn.

Claims 1-38 have been withdrawn and should be cancelled. The Amendments to claims 39,41 and 44-50 have now been entered. Claims 40,42 and 43 have been cancelled. The withdrawn claims 1-38 are still present and should be formally cancelled.

Claims 39,41 and 44-50 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

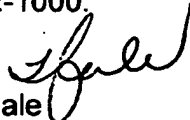
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria Hale whose telephone number is 571-272-4984. The examiner can normally be reached on Tues.-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3765

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gloria Hale  
Primary Examiner  
Art Unit 3765

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8-17-06  
PIPE WEB  
OCT 07 2005  
PNT & TRADEMARK OFFICE

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To be  
entered  
with  
RCE  
8-17-06

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Damir et al.

Attorney Docket No. SWAD-1-1002

Serial No.: 10/751,070

Group Art Unit: 3765

Filing Date: January 2, 2004

Examiner: HALE, G.

Title: SWADDLING BLANKET

RESPONSE TO FINAL OFFICE ACTION

TO THE COMMISSIONER OF PATENTS:

AMENDMENT AND RESPONSE

OK to  
enter  
on 8/30/07

25315


CUSTOMER NUMBER

-1-

SWAD-1-1002/FOA

BLACK LOWE & GRAHAM<sup>INC</sup>

701 Fifth Avenue, Suite 4800  
Seattle, Washington 98104  
206.381.3300 • F: 206.381.3301

<b>Index of Claims</b> 	Application No.	Applicant(s)	
	10/751,070	DAMIR ET AL.	
	Examiner	Art Unit	
	Gloria Hale	3785	

J	Rejected
=	Allowed

-	(Through numeral) Cancelled
+	Restricted

N	Non-Elected
I	Interference


A	Appeal
O	Objected

Claim		Date			
Final	Original				
	1	2	3	4	5
	6	7	8	9	10
	11	12	13	14	15
	16	17	18	19	20
	21	22	23	24	25
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Claim		Date			
Final	Original				
	51	52	53	54	55
	56	57	58	59	60
	61	62	63	64	65
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	76	77	78	79	80
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	86	87	88	89	90
	91	92	93	94	95
	96	97	98	99	100

Claim		Date			
Final	Original				
	101	102	103	104	105
	106	107	108	109	110
	111	112	113	114	115
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	121	122	123	124	125
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	146	147	148	149	150

10/7/05

Search Notes		Application No.	Applicant(s)	
		10/751,070	DAMIR ET AL	
		Examiner	Art Unit	
		Gloria Hale	3785	

SEARCHED			
Class	Subclass	Date	Examiner
2	69, 1A.5 8385 94, 95, 108	8.4.04	EM
	113-115, 105 106, 75		
5	482 488, 495		
	494	search	
		update	
		3.30.05	EM
		3.2.06	EM
		11/7/07	EM
		2301	EM

INTERFERENCE SEARCHED			
Class	Subclass	Date	Examiner

SEARCH NOTES (INCLUDING SEARCH STRATEGY)		
	DATE	EXMR
Perm Inv Nn Srch	8-7-04	EM
EAST BLS SRCH HISTORY PRINTOUT	8-5-04	EM
SRCH ASSIST. - Cl. 5 - Exmr Gross	8-5-04	EM
IDS Flag Clearance		
	3.2.06	EM
	2.30.7	EM